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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,321	07/10/2001	Michael Lee Vatter	8160	8449

27752 7590 11/20/2002

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER

BERMAN, ALYSIA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,321

Applicant(s)

MOTLEY ET AL.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Receipt is acknowledged of the change of address filed April 22, 2002, the amendment filed July 24, 2002 and the information disclosure statements filed July 16, 2002 and August 22, 2002. Claims 3, 9, 11 and 14 have been amended. Claims 1-14 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,412,004 (004).

This rejection is maintained for reasons of record in the Office Action mailed January 24, 2002, paper no. 3.

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Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,412,004 (004) as applied to claims 1-10 and 12-14 above, and further in view of Hawley, G. G., The Condensed Chemical Dictionary, 10th Ed., Van Nostrand Reinhold Co., New York. (1981) pages 121, 385,434 and 686.

This rejection is maintained for reasons of record in paper no. 3.

Response to Arguments

Applicant's arguments filed July 24, 2002 have been fully considered but they are not persuasive.

Instant independent claim 1 requires an emulsion comprising a continuous phase comprising an emulsifying crosslinked siloxane elastomer and a solvent for the siloxane elastomer; and at least one discontinuous phase comprising solid particles wherein the discontinuous phase has a droplet size distribution range of about 0.1-100 microns.

Instant independent claim 14 requires a composition comprising about 0.1-15 wt.% of an emulsifying crosslinked siloxane elastomer having an average particle size less than 20 microns, 10-80 wt.% of a solvent for the siloxane elastomer, and at least about 1% air.

Applicant argues that the instant claims are not obvious over US '004 because it does not teach or suggest a composition including a solid particle-containing discontinuous phase with a droplet size distribution ranging from about 0.1-100 microns. Throughout US '004 solid particle materials are disclosed for use in the compositions. At column 9, lines 18-21 solids such as sugars and inorganic salts are disclosed for use in the water phase, which is the discontinuous phase. It is within the skill in the art to

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select optimal parameters in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). Therefore, absent evidence of unexpected results, the droplet size distribution range of the discontinuous phase is not given patentable weight over the prior art. "It is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Only if the "results optimizing a variable" are "unexpectedly good" can a patent be obtained for the claimed critical range. *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); see also *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc). Applicant has not provided any evidence of unexpected results obtained from the instantly claimed droplet size range over the prior art.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the instantly claimed average particle size of the particles and aerating the composition) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The only reference to particle size in the claims is directed to the particle size of the emulsifying crosslinked silicone elastomer that is contained in the continuous phase in instant claim 14. The claims as written do not requiring aerating *per se*, but only require at least 1% air. As disclosed by Applicant in the instant specification, air is incorporated into the compositions by conventional mixing. As stated in paper no. 3, it is the

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Examiner's position that simple mixing would incorporate at least 1% of air into a composition. Therefore, the composition of US '004 necessarily contains at least 1% air because it is mixed in a conventional manner.

In response to applicant's argument that the references fail to teach or suggest uniform distribution of the particles on the skin, a limitation directed to an inherent property that is based on a future intended use does not render claims to a composition patentable. The claims are directed to a composition. Any properties exhibited by that composition are inherent. A prior art composition containing the same components would be expected to exhibit the same properties absent evidence to the contrary. Applicant has not provided any evidence of record showing that the instantly claimed composition exhibits properties different from the prior art composition.

Applicant argues that Hawley does not overcome the deficiencies of US '004. As stated above, it is the Examiner's position that US '004 teaches all the limitations of the claims except the particular preservatives of instant claim 11. Hawley teaches that various of those preservatives are conventionally used in the art. Therefore, Hawley makes up this deficiency in US '004.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It is within the skill in the art to adjust parameters in a composition in order to optimize the properties of the composition. One of ordinary skill in the art would be motivated to adjust droplet sizes of components in compositions in order to achieve beneficial effects such as stability and uniformity.

In response to Applicant's "obvious to try" argument, it is noted that absolute predictability is not required and is not standard. A reasonable expectation of success is the standard. Because the reference is silent as to the droplet size of the discontinuous phase, the fact that it is within the skill in the art to optimize parameters and the fact that it is known in the art that smaller droplet sizes usually result in more stable emulsions, one of ordinary skill in the art would have a reasonable expectation of success using a small droplet size of discontinuous phase as instantly claimed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

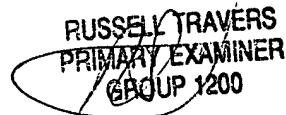
Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
October 30, 2002


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200